



SEP 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 22, 36 and 50 of the morning section and questions 13, 15, 25, and 30 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On January 29, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. §

32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the

answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional 1 point for morning question 50. Accordingly, petitioner has been granted an additional 1 point on the Examination. No credit has been awarded for morning questions 22 and 36 and afternoon questions 13, 15, 25, and 30. Petitioner's arguments for these questions are addressed individually below.

Morning question 22 reads as follows:

22. Which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Appeals and Patent Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of Appeals and Patent Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.
- (C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.
- (D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.
- (E) None of the above.

The model answer is selection B.

See MPEP § 1209, p.1200-23, "Participation by Examiner." As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)

Petitioner argues that answer (E) is correct on the basis that none of the statements contained in answers (A) through (D) is correct. Specifically, petitioner argues that model answer (B) is incorrect "because MPEP §1209 provides that after confirmation of an oral hearing, if no appearance is made at the scheduled hearing, the appeal will be determined on brief."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the MPEP indicates that answer (E) is correct, model answer (B) is a restatement of the second paragraph under the subheading "PARTICIPATION BY EXAMINER" in MPEP §1209. Of course, the examiner must appear in order to participate in an oral hearing. The part of the MPEP which petitioner has cited concerns how an appeal is decided when "no appearance is made." Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 36 reads as follows:

36. In July 1999, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 5, 1997. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

(A) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims

(B) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.

(C) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.

(D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.

(E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

The model answer is selection C.

It is essential that Sam file broader claims and indicate his intention to broaden within the two year time limit of 35 U.S.C. § 251. See MPEP § 1412.03, p.1400-13, and In re Graf, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). As to answer (D), according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived sua sponte. As to a continuation application, they may also issue at different times as explained at MPEP § 1451, p.1400-38. Since (C) is true, (A), (B) and (E) are false. Further as to (E), claims reading on subject matter not covered by the original claims are broader.

Petitioner argues that answer (D) is correct “because 37 CFR 1.177 requires that all divisional applications issue simultaneously.” Petitioner’s arguments have been fully considered but are not persuasive. As explained in the paragraph above, however, according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived sua sponte. Accordingly, model answer (C) is correct and petitioner’s answer (D) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 50 reads as follows:

50. Which of the following is true?

(A) In order to have a reissue application expedited, the reissue applicant should file a Petition to Make Special.

(B) Once a reissue issues, the date on which the maintenance fee is due is calculated from the date of issuance of the reissue certificate.

(C) A dependent claim may not be broadened during a reexamination proceeding.

(D) If the examiner raises a new ground of rejection in the Examiner’s Answer, the applicant has the option of continuing with the appeal or asking that prosecution be reopened.

(E) None of the above.

The model answer is selection D or E.

As to (A) see MPEP § 1442. All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other “special” applications. Therefore, it would do no good to file a petition to make special. As to (B), maintenance fees are always calculated from the patent issue date. MPEP §§ 2506 and 1415.01. As to (C), claims may not enlarge the scope of the claims in a patent during a reexamination. However, since a dependent claim is construed to contain all the limitations of the claim from which it depends, the dependent claim must be at least as narrow as the independent claim from which it depends, and thus does not broaden the patent. Thus, one does not necessarily enlarge the scope of the patent by broadening the claim. 37 C.F.R. § 1.193(a)(2); MPEP §§ 1412.03 (page 1400-13), 2258, subsection III, A (page 2200-60). As to (D), it is accepted due to ambiguity contained therein.

Petitioner argues that answer (C) is correct. Petitioner’s arguments have been fully considered but are not persuasive. Based on petitioner’s arguments, it appears that petitioner has confused MPEP statements relating to reissue applications with MPEP statements relating to reexamination of an application. Contrary to petitioner’s arguments that answer (C) is correct, the paragraph above explains why answer (C) is incorrect. Accordingly, model answer (E) and answer (D) are correct, and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. On February 3, 1999, you filed an application for inventor Sam, fully disclosing and claiming only the following:

Claim 1. A system for preventing unauthorized entry into a garage, comprising: an electric garage opener coupled to a computer and to a video camera.

You received a non-final Office action dated February 4, 2000, wherein the examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Dan. The examiner attached a copy of Dan’s journal article published on July 4, 1997, fully disclosing an electric garage opener coupled to a computer and to a video camera. Which of the following actions, if taken by you, can overcome the rejection in accordance with proper USPTO practice and procedure?

(A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.

(B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).

(C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.

(D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.

(E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

The model answer is selection E.

MPEP § 706.02(b). (A) is incorrect because the Dan reference includes all the elements of claim 1. (B) is incorrect because the Federal holiday is merely to move the statutory bar date to the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). (C) is incorrect because a 37 C.F.R. § 1.131 affidavit can not be used to overcome a rejection under 35 U.S.C. § 102(b). (D) is incorrect because the rejection was not made under 35 U.S.C. § 103.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner cites MPEP § 706.02(b) in support of answer (A). As indicated in the paragraph above, however, the fact pattern recited in the question makes answer (A) an incorrect answer. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 15 reads as follows:

15. In December 1987, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the

next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 1999, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2000. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2000. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

- (A) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.
- (B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.
- (C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.
- (D) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.
- (E) None of the above.

The model answer is selection D.

35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy's device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not true since §102(a) applies only when the invention is publicly known by others. Since (D) is true, (E) is not.

Petitioner argues that answer (C) is correct. Petitioner contends, in effect, that Moly's disclosure of the invention to Sue and Tom made the invention known by others within the meaning of 35 USC 102(a). The fact pattern recited in the question, however, makes clear that the invention never became publicly known by others prior to Troy's application filing. As a result, Troy is not precluded by 35 USC 102(a) from obtaining a patent on his idea on that basis. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this

question is denied.

Afternoon question 25 reads as follows:

25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.

II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.

III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I
- (B) II
- (C) III
- (D) I and II
- (E) None of the above.

The model answer is selection B.

MPEP § 2144.03. I is *incorrect* because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is *incorrect* because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner explains that she chose answer (D) based upon a misinterpretation of statement (I). Specifically, petitioner thought that the phrase "at any time during the prosecution" referred to when the "examiner's statement" occurred, rather than when "[A]pplicant can traverse" the examiner's statement. In view of the clear wording and punctuation of statement (I), however, petitioner's misinterpretation of statement (I) was incorrect. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 30 reads as follows:

30. You prepare and file a patent application directed to an invention for improving the safety of research in the field of recombinant DNA. Your client, Inventor Joe, informs you he has licensed exclusive rights to his invention to a major pharmaceutical company. Inventor Joe also informs you that he is aware that another pharmaceutical company, Titan Pharmaceuticals, learned of the invention from a paper he presented at a technical conference, and is preparing to use the technology in its commercial research labs in the United States. Inventor Joe demonstrates that Titan is about to begin practicing the invention by showing you a rigid comparison of Titan's intended activities and the claims of the application. He also informs you that although he is currently in very good health, he is 67 years old and fears he will not be in good health when the invention reaches its peak commercial value. Accordingly, if possible he would like for you to expedite prosecution in the simplest, most inexpensive way. Given the foregoing circumstances, which of the following statements is most correct?

- (A) Since the invention relates to improving the safety of research in the field of recombinant DNA, you should recommend filing a petition to make special on that basis.
- (B) Since Titan is actually practicing the invention set forth in the pending claims, you should recommend filing a petition to make special on that basis.
- (C) You should recommend filing a petition to make special on the basis of Inventor Joe's age.
- (D) Statements (A), (B) and (C) are equally correct.
- (E) Statements (A), (B) and (C) are each incorrect.

The model answer is selection C.

A petition to make special may be made simply by filing a petition including any evidence showing that the applicant is 65 years of age or more, such as a birth certificate or a statement from the applicant. No fee is required. MPEP § 708.02. Although a petition to make special as indicated in statement (A) is likely available, it would require a petition fee. *Id.* A petition to make special as indicated in statement (B) is likely not available because such a petition may not be based on prospective infringement. *Id.* Also, even if a petition as indicated in statement (B) were available, it would require a petition fee. Thus, neither of these options would be the most inexpensive. (A) also requires a statement explaining the relationship of the invention to safety of research in the field of

recombinant DNA research.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

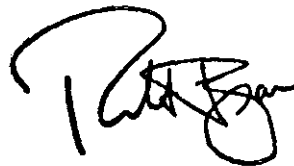
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, 1 point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy